

REMARKS**A. INTRODUCTION**

We amended the drawings to overcome the 37 C.F.R. § 1.83(a) objection. We also amended claims to make clear the antecedent basis for claim terms especially “curvature.” We rewrote as independent claims some dependent claims that the PTO did not reject over the prior art. We also traverse other prior art rejections.

B. OBJECTIONS TO DRAWINGS AND TO CLAIMS BASED ON THE DRAWINGS

We traverse the drawing objection and the objections to certain claims under 37 C.F.R. § 1.83(a) (“The drawing in a nonprovisional application must show every feature of the invention specified in the claims.”) The drawings do show the features. The shape of the roller shown in the drawings returns the roller to a “normal” position. Thus, the shape is an exemplary “means for returning the roller to a first longitudinal line . . .” Because the drawing does not show the line, amended drawings add the line. In addition, we added language to paragraph 0023 of the specification to explain the line (and the corresponding line on the other surface).

The rule does not necessarily require that every element have a reference numeral. Thus, in *Aspex Eyewear, Inc. v. E’Lite Optik, Inc.*, 2002 U.S. Dist. LEXIS 14834 (N.D. Tex. 2002) (copy attached), the accused infringer argued that the patentees failure to number all features in the drawings and specification invalidated the patent under § 112. The court rejected that defense because the defendant did “not show, however, how the failure to identify and draw these terms as separate features renders the claim language unclear or vague, or incapable of being understood by one skilled in the art. This failure is therefore not a violation of § 112.” *Id.* at *77. We recognize that *Aspex* is an infringement suit dealing with the drawings in an already-issued patent and is not a statement of the propriety of PTO regulations. Neverthe-

less, we submit that with the explanation added to ¶ 0023, the drawings now conform to 37 C.F.R. § 1.83(a).

The addition to ¶ 0023 also is not new matter because drawings as filed already showed the shape of the surfaces, and the drawings inherently show that the roller would return to the normal position when force is released.

C. THE AMENDED CLAIMS OVERCOME THE § 112, ¶ 2 REJECTION

The office actions rejects independent claims 9, 10, 13, 24 and 25 because of insufficient antecedent bases for “the curvature” (“radius” in claim 25). The amendment to those claims corrects the language. For example, we amended claim 9 after “a first curved, convex surface on the first portion,” adding “having a first curvature with a first radius of curvature.” We treated the second surface and curvature similarly. That change allowed us to delete extraneous language as the amended claim shows.

Where appropriate, this amendment also added antecedent basis for “radius.”

D. THE CLAIMS DISTINGUISH OVER THE CITED ART

Preliminarily, we note that the office action discusses how the prior art applies to several claims that are not specifically rejected. For example, page 7 mentions claims 19 and 20, but the rejection on page 6 refers only to claim 18. Likewise, paragraph 15 mentions claim 8, but the rejection on page 8 does not mention this claim.

Regarding the § 102 rejection of claims 9, 22 and 24 over Ranz, we amended claim 9 to include the language from claim 2, a claim that the office action did not reject over the prior art. We changed the dependency of claims 2 and 8, so that they now depend from claim 9.

Claims 22 and 24 distinguish over Ranz, in part, because each requires “a wholly convex outer surface.” The discussion in the office action refers to most elements by reference numerals in Ranz, but the office action skips any reference to “wholly convex outer surface” As we stated in our last

response, the phrase “wholly convex” means a surface that is entirely convex. That distinguishes Ranz, which has the two, long flat surfaces.

The § 102 rejection of claim 18 relies on the Koshaba design patent. The amendments to the claim distinguish the claim from the reference. Please remember that applicant’s device rests on a flat, essentially horizontal surface such as the floor. Its shape allows a person lying on the device to move horizontally to cause the device to roll. Though Koshaba has curved surfaces, horizontal force would not cause it to roll from the position shown in its drawings. Thus, we added the concept that rolling occurs when “generally horizontal force is applied to the roller.” Insofar as one may argue that Koshaba would roll if it were rotated 90° and then a horizontal force is applied, the claim also requires that the roller will return to its normal position “when force is removed from the roller.” Koshaba would not do that.

We cancelled rejected claim 21. No further discussion of that claim is necessary.

The amendment to claim 9 also overcomes the § 103(a) rejection of claim 9 and of claims 10, 11 and 12, which depend on claim 9. The amendment to claim 13 adds the language from claim 2, which was not rejected over the prior art. That amendment also overcomes the § 103(a) rejection of that claim. Claim 14 depends from claim 13 and is allowable.

E. CONCLUSION

We believe that the remaining claims define over the prior art and overcome the § 112 rejections. If you have any questions suited for telephone discussion, please call us for a brief interview.

May 12, 2006



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